

REMARKS

Claims 14, 15, 31 and 32 have been cancelled in this Amendment and Response. Claims 13 and 30 have been amended in this Amendment and Response. As a consequence, Claims 1-13, 16-30 and 33-41 are currently pending in this application.

Each of the pending claims require that either the support member or the support sleeve of the claimed motorcycle stand include a self-lubricating material. The Examiner has rejected all such claims as being obvious in light of a Paradigm Stand, in view of German Patent 2,601,223 to Peddinghaus. The Examiner's obviousness rejection is legally incorrect. Applicant thus requests that, in light of amendments to Claims 13 and 30, the pending rejection be withdrawn and that all independent and their dependent claims be allowed.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *ACS Hospital Sys. v. Montefiore Hospital*, 221 USPQ 929, 933 (Fed. Cir. 1984). Before obviousness may be established, the Examiner must therefore show that there is either a suggestion in the art to produce the claimed invention or a compelling motivation based on sound scientific principles. *Ex parte Kranz*, 19 USPQ2d 1216, 1218 (BPAI 1981). Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness because both the Paradigm Stand and Peddinghaus references are devoid of any suggestion to use a self-lubricating material in connection with either a support member or sleeve of a motorcycle stand. It appears that in the present case, the only suggestion for the Examiner's combination of the teachings in the Paradigm Stand and Peddinghaus improperly stems from the Applicant's own disclosure and not from the cited references themselves. At best, the Examiner's comments regarding obviousness appear to amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at Applicant's invention because they would have had the necessary skills to combine the references to achieve the claimed inventions. This is an inappropriate standard for obviousness.

In brief, neither of the references alone or in combination provide an impetus necessary to cause one skilled in the art to combine the teachings of the references in the way the Examiner has done. The Examiner seems in essence to be stating that it would have been "obvious to try"

modifying various parameters, and indeed selecting entirely different components and combinations having distinct identifying characteristics, in order to produce the claimed invention. The Federal Circuit has provided clear direction with respect to arguments based on an “obvious to try” theory. The court has held that an “obvious to try” situation exists when a general disclosure may pique a scientist’s curiosity, such that further investigation might be done as the result of a disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued. *In re Eli Lilly & Co.*, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). The court held that “obvious to try” is not to be equated with obviousness under 35 U.S.C. § 103. *See Gillette Co. v. S.C. Johnson & Son, Inc.*, 16 USPQ2d 1923, 1928 (Fed. Cir. 1990).

It is also well established that in an obviousness determination, one may not substitute the factual inquiry of whether to combine references and that inquiry must be thorough and searching. *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). It must be based on objective evidence of record. *Id.* A showing of a suggestion, teaching or motivation to combine the prior art references is an “essential component of an obviousness holding.” *Brown and Williamson Tobacco Corp. v. Phillip Morris, Inc.*, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000). As many courts have held, “the best defense against the subtle, but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *In re Dembiczaik*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). It is abundantly clear that “there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.” *In re Dance*, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). Moreover, “particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claims.” *In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). The Examiner simply has not met his burden.

It is also important to note that a simple invention may be patentable, even if the invention comprises a combination of features known in the art, provided the combination itself is not obvious. *See In re Dembiczaik*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); *In re Dance*, 48 USPQ2d 1635, 1637

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(Fed. Cir. 1998); *In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000); *In re Sponnoble*, 160 USPQ 237, 243 (CCPA 1969) (“A patentable invention, within the ambit of 35 U.S.C. § 103, may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use.”) (emphasis omitted). It is insufficient that the prior art merely discloses the components of a patented invention, either separately or used in other combinations - there must be some teaching, suggestion or incentive to make the combination made by the inventor. *Northern Telecom v. Datapoint Corp.*, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). That knowledge may have been within the province of the ordinary artisan does not in and of itself make itself obvious absent clear and convincing evidence of such knowledge. See *C.R. Bard, Inc. v. M3 Sys., Inc.*, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). Care must be taken to avoid hindsight reconstruction while using the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. *Grain Processing Corp. v. American Maize Prod. Co.*, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). Again, these standards have not been met.

Finally, a prerequisite to making a finding on the scope and content of the prior art is to determine what prior art references are pertinent, *i.e.*, analogous to the claimed invention. *In re Clay*, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). Whether a prior art reference is analogous is a question of fact. *Id.* A reference is analogous if it is from the same field of endeavor as the invention. *Id.* at 658-59. Similarity in the structure and function of the invention and the prior art is indicative that the prior art is within the inventor’s field of endeavor. *In re Deminski*, 230 USPQ 313, 315 (Fed. Cir. 1986). If a reference is outside the inventor’s field of endeavor, it is still analogous art if the reference “is reasonably pertinent to the particular problem with which the inventor is involved.” *Clay*, 23 USPQ2d at 1060. Peddinghaus is not analogous art, as it is outside of the inventor’s field of the endeavor, and is not reasonably pertinent to the particular problem with which the inventor is involved. For all of these reasons, it is inappropriate to combine Peddinghaus with the Paradigm Stand, which also precludes the Examiner’s finding of obviousness.

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Based upon the foregoing, Applicants believe that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution and/or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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